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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/675,684

09/30/2003

Arthur Louis Gaetano JR.

IT-03-005

6726

40604 7590 05/01/2009  
MITEL NETWORKS CORPORATION  
MICHELLE WHITTINGTON, ESQ.  
7300 WEST BOSTON STREET  
CHANDLER, AZ 85226

EXAMINER

WORJLOH, JALATEE

ART UNIT

PAPER NUMBER

3685

MAIL DATE

DELIVERY MODE

05/01/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/675,684	<b>Applicant(s)</b> GAETANO ET AL.	
	<b>Examiner</b> Jalatee Worjloh	<b>Art Unit</b> 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4-8-09.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 10-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 8, 2009 has been entered.
2. Claims 1-35 are pending.
3. Claims 1-9 have been examined.

### ***Response to Arguments***

4. Applicants' arguments filed April 8, 2009 have been fully considered but they are not persuasive.
5. In response to applicants' argument that "each of said components specifically selected for storage because each of said component is compatible for operating with said target hardware device", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.
6. Applicants' argue that Russell does not teach the license is generated from the stored software components for the target hardware device and stored in a virtual warehouse storage for later use. However, the Examiner respectfully disagrees. At least paragraphs [0045] and [0047] teach these features.

7. All other arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

8. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. The term "acting as" in claim 1 is a relative term which renders the claim indefinite. The term "acting as" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear whether or not the hardware device is a separate entity.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-3, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2002/0049679 to Russell et al. ("Russell") in view of US Patent No. 6189146 to Misra et al. ("Misra").

Referring to claim 1, Russell discloses a client site having a target hardware device (i.e. user-network enabled device), said hardware device having a unique identifier see paragraphs [0009] & [0049] – UND with hard drive serial number), a virtual warehouse website (i.e.

protected database) comprising a personal inventory of intangible software specifically selected for storage because each of said component is compatible with said target hardware device(see paragraphs [0011] & [0031]), a license generator generating a software site license comprising one or more of said components for said target hardware device, aid software site license being stored in said virtual warehouse storage for later use (see paragraphs [0047] &[0045]) and a programming workstation (i.e. media player) receiving said software site license from said virtual warehouse storage for said target device (see paragraphs [0012] &[0014]). Russell does not expressly disclose the programming workstation is a separate entity and receiving said software site license from said virtual warehouse storage on behalf of said target device.

However, Misra discloses this feature (see fig. 1 and related text - the license server receives the license from the license generator and sends it to the client). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Russell to include the features of Misra. One of ordinary skill in the art would have been motivated to do this because it prevents issued license form being copied form one client machine to another (see col. 3, lines 15-20). Also, modifying the reference to have more than one parts perform a task previously performed by one part is analogues to making functions, structures, or actions separable. It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art (see *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) and MPEP §2144.04 V.C).

Referring to claim 2, Russell discloses the system wherein said programming workstation receives an electronic file transfer comprising said license (see paragraph [0026]).

Referring to claim 3, Russell discloses the system wherein said programming workstation stores a copy of said site license (see claim 28).

Referring to claim 7, Russell discloses the system wherein said license sales site receives a purchase order from said client site comprising said target hardware device in response to said order, said license sales site establishes said virtual warehouse for said client site and places said licensable components for said target hardware device in said virtual warehouse (see claim 1 above).

Referring to claim 9, Russell discloses a representative of said client site (i.e. user) and a purchase order prepared by said representative and received at said license sales site, said order comprising said target hardware device, said representative having said programming workstation and installing said license to said target sales device prior to delivering said target to said client site (see claim 1 above).

12. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell and Misra as applied to claim 1 above, and further in view of U.S. Patent No. 7209902 to Stefik et al. ("Stefik").

Russell discloses a virtual warehouse and performing integrity check (see claim 1 above and paragraph [0063]). Russell does not expressly disclose the system wherein said virtual warehouse comprises a multi-password protected website comprising entry of a password unique to said client site and an ID unique to said target hardware device or comprising a priority level of access to said virtual warehouse. Stefik discloses the system wherein said virtual warehouse comprises a multi-password protected website comprising entry of a password unique to said

client site and an ID unique to said target hardware device or comprising a priority level of access to said virtual warehouse (see claims 1 and 22). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Russell to include a virtual warehouse comprises a multi-password protected website comprising entry of a password unique to said client site and an ID unique to said target hardware device and a priority level of access to said virtual warehouse. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from accessing the system.

13. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell as applied to claim 1 above.

Referring to claim 6, Russell discloses wherein said programming workstation displays said licensable components (see claim 1 above). Russell does not expressly teach displaying for confirmation from a user prior to said license generator generating said software site license. However, this is an intended use feature and the Examiner notes that the workstation of Russell is capable of performing the process. "A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art, if the prior art has the capability to so perform" (see MPEP 2114 and Ex parte Masham,"2 USPQ2d 1647 (1987)). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Russell to display said licensable components for confirmation from a user prior to said license sales site generating said software site license. One of ordinary skill in the art would have been motivated to do this because it ensures that the user wants to purchase a particular license.

Note. Functional recitation(s) using the word “for” or other functional language (have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

### ***Conclusion***

14. As per the withdrawn claims, when claim text in clean version is required. **The text of all pending claims not being currently amended shall be presented in the claim listing in clean version**, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, i.e., without any underlining.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and 571-273-6714 for Non-Official /Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/  
Primary Examiner, Art Unit 3685